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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/849,625 | 05/04/2001 | R. Michael McGrady | D-1137 | 9504 |

28995 7590 01/19/2007

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| EXAMINER | |
|---|---|
| ADE, OGER GARCIA | |
| **ART UNIT** | **PAPER NUMBER** |
| 3627 | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|---|---|---|
| 3 MONTHS | 01/19/2007 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/849,625 | MCGRADY ET AL. | |
| | Examiner | Art Unit | |
| | Garcia Ade | 3627 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *05 June 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1 – 4, 9, 13 and 14* is/are pending in the application.

4a) Of the above claim(s) *15, 16, and 18 – 21* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 – 4, 9, 13 and 14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 15, 16, and 18 – 21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected Groups II and III, there being no allowable generic or linking claim. Applicants timely traversed the restriction (election) requirement in the reply filed on August 26th, 2006.

2. Applicants' election with traverse of Group I, claims 1 - 14 in the reply filed on August 26th, 2006 is acknowledged. The traversal is on the ground(s) that the restriction requirement is legally improper. This is not found persuasive because inventions Groups I – III are related as subcombinations disclosed as usable together in a single combination (see Requirement for Restriction/Election).

The requirement is still deemed proper and is therefore made FINAL.

3. Applicants amended claims 1 – 4, 9, 13 and 14, and Applicants cancelled claims 5 – 8, and 10 –12. Now, claims 1 – 4, 9, 13 and 14 are presented for examination.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 – 4, 9, 13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by King et al. [WO 98/50840].

**As per claims 1 – 4, 9, 13 and 14**, Kind discloses taking a first quantity of a first type of medical item from a first storage location within a pharmacy [see table 8 that shows maintaining transaction records for two stocks (an area designated for storage of large volumes may be maintained separately from the working stock)]; providing at least one input through at least one input device [see figure 1, ***instead of manually typing*** in each drag received at the pharmacy console or CnSafe computer, a commercially available bar code ***scanning device 23*** may be used to gather the needed drug information (i.e., drug type, quantity, expiration date, destination, etc.), page 8, lines 18 - 22] indicative of taking the first quantity of the first type of medical item from the first storage location in the pharmacy for use in a second compounding activity [see table 9 and page 10, line 10 (e.g. to be ***compounded*** then back to pharmacy as new product]; including in at least one data store through operation of at least one processor data indicative of the first type of medical item from as an outstanding medical item that was taken for use in a compounding activity but has not had a resulting compound stored into the pharmacy [page 4, last paragraph and page 5, lines 1 – 11 (e.g. the hospital pharmacy ***console processor*** may be arranged in a network configuration to communicate with one or more automatic medicine dispenser units), and line 5 (e.g. ***processor interface***)]; subsequent to steps (a), (b), and (c), creating an amount of a compound using the first quantity of the first type of medical item taken in step (a), wherein creating the compound includes one of using all of the

first quantity in creating the amount of the compound or wasting a second quantity of the first type of medical item [see page 10, lines 5 – 15 (e.g. drug tracking occurs at each of the following steps (1-8)];subsequent to step (d), choosing via at least one display screen the first type of medical item from data store data indicative of outstanding medical items that were taken for use in a compounding activity but have not had a resulting compound stored into the pharmacy [see table 2A, page 16 (e.g. screen for the editing process)]; linking through operation of the at least one processor, the compound created in step (d) to the first type of medical item chosen in step (e) [see figure 3, a ***communications link*** between the computer, the interface computer, and the pharmacy console computer of the]; including in the at least one data store through operation of the at least one processor responsive to the linking in step data indicative of storing the amount of the created compound in the pharmacy [see figure 1, via ***data processor 14***]; comparing through operation of the at least one processor, the first quantity taken in step (a), any second quantity that was wasted in the compounding in step (d), and the amount of the created compound indicated as stored in the pharmacy [see table 5, which shows a proactive diversion tracking report which ***allows comparison*** ..., page 18 and 19, and table 9].

***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Garcia Ade whose telephone number is 571.272.5586. The examiner can normally be reached on M-F 8:30AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571.272.6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Garcia Ade
Examiner
Art Unit 3627

ga

Andrew Joseph Rudy
Primary Examiner, AU 3627